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MENDEL-BIOTECHNOLOGY

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NO. 709 P. 6

Patent Application

DEC 16 2004

Docket No.: MBI-0022CIP

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No.: 10/675,852 )  
In re application of: Jacqueline HEARD, *et al.* )  
Confirmation No. 1145 )  
Filed: 30 September, 2003 )  
Art Unit: 1638 )  
Examiner: To Be Assigned )  
Docket No. MBI-0022CIP )  
Customer No. 23678 )

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION TO ACCEPT AN UNINTENTIONALLY DELAYED CLAIM**  
**UNDER 37 CFR 1.78(a)(3)**

Dear Sir:

Applicants respectfully request the addition of U.S. Application Nos. 10/171,468, filed June 14, 2002, 09/713,994, filed November 16, 2000, 60/166,228, filed November 17, 1999, 09/713,994, filed November 16, 2000, 10/112,887, filed March 18, 2002, 10/286,264, filed January 23, 2003, 09/533,030, filed March 22, 2000, 60/125,814, filed March 23, 1999, 10/225,068, filed August 9, 2002, 09/837,944, filed April 18, 2001, 60/310,847, filed August 9, 2001, 60/336,049, filed November 19, 2001, 10/225,066, filed August 9, 2002, 10/374,780, filed February 25, 2003, 10/666,642, filed September 18, 2003, 60/434,166, filed December 17, 2002, and 60/411,837, filed September 18, 2002 to be added to the list of domestic priority data as claimed by Applicant for the above-referenced patent application 10/675,852 (the "Instant" application).

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#### Statement of Facts.

- 1) Applicants filed the instant application on September 30, 2003 including 19 priority documents listed in the first paragraph of the specification as well as in the Sequence Listing, the Application Data Sheet, and an unexecuted Declaration for Utility Patent Application filed with the instant application. These 19 applications included U.S. patent application nos. 10/412,699, 09/533,030, 60/125,814, 09/713,994, 60/166,228, 60/197,899, 60/227,439, 10/112,887, 10/286,264, 10/225,068, 10/225,066, 10/374,780, 09/837,944, 10/171,468, 60/310,847, 60/336,049, 60/434,166, and 60/411,837. The listed priority applications also included an application for which the application number was not known at the time the instant application was filed. This application was originally listed as "Polynucleotides and Polypeptides in Plants, filed September 18, 2003". This application has now been assigned Application No. 10/666,642 and is the only application filed by Applicants on September 18, 2003.
- 2) The earliest priority document listed in the first paragraph of the instant application is U.S. Provisional Application No. 60/125,814 filed March 23, 1999.
- 3) The relationship between the non-provisional priority documents to the instant application (continuation-in-part) and the provisional priority documents was apparently not of sufficient clarity at the time of filing to warrant inclusion on the filing receipt (Applicants "claimed the benefit of" all priority applications).
- 4) The filing receipt for the instant application was mailed on December 24, 2003. The filing receipt listed one non-provisional application, 10/412,699 and did not list the 18 other provisional and non-provisional applications listed above.
- 5) The relationship between a number of the priority applications and the instant application was made in the unexecuted Declaration filed with the instant application. The declaration stated that the instant application "claim[s] the benefit of priority under Title 35 United States Code, § 119(e) of any United States provisional application(s) listed below" and "this is a continuation-in-part application filed under the conditions set forth in 35 United States Code, § 120, which discloses and claims subject matter in addition to the prior copending application(s) listed below". Many of these applications were pending at the time

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the instant application was filed, including provisional application 60/434,166, and non-provisional applications 09/713,994, 10/112,887, 10/288,264, 10/225,068, 10/225,066, 10/374,780, and 10/666,642.

- 6) At the time of the filing of this petition, examination on the merits has not yet been initiated, and an examiner has not yet been assigned. The instant application has not yet been published.
- 7) Applicants no longer wish to claim two of the priority documents originally listed in the first paragraph of the specification, the Application Data Sheet, the Declaration and the Sequence Listing (60/197,899 and 60/227,439)
- 8) The entire delay between the date this claim was due (37 CFR 1.78(a)(2)) and the date Applicants file this petition to correct the claim to priority applications was unintentional.

Applicants have submitted with this petition a Supplemental Application Data Sheet and a Preliminary Amendment to the first paragraph in the specification to clarify relationships prior to examination of the instant application on the merits. Therefore, Applicants assert that the failure to clarify the relationships between the non-provisional applications and the instant application did not negatively impact the natural progression of prosecution for the instant application. In other words, had Applicants clarified the relationship between the non-provisional priority documents and the instant application in the specification as originally filed, the natural progression of publication and prosecution would be as it has occurred to date.

Applicants file herewith the Preliminary Amendment that amends the specification to clarify relationships between the non-provisional priority applications and the instant application. A copy of this amendment is attached hereto. Applicants also include a fee transmittal authorizing the Commissioner to charge Mendel Biotechnology, Inc. Deposit Account No. 50-1025 the amount of \$130.00, the fee for such a petition as set forth under 37 C.F.R. §1.17(i), plus the surcharge set forth in 37 CFR 1.17(t) the amount of \$1370.00, or charge the correct fee to said Deposit Account, as the Commissioner deems appropriate.

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Applicants respectfully request that US Non-provisional Application Nos. 10/412,699 (filed April 10, 2003), 09/533,030 (filed March 22, 2000), 09/713,994 (filed November 16, 2000), 10/112,887 (filed March 18, 2002), 10/286,264 (filed November 1, 2002), 10/225,068 (filed August 9, 2002), 10/225,066 (filed August 9, 2002), 10/374,780 (filed February 25, 2003), 09/837,944 (filed April 18, 2001), 10/171,468 (filed June 14, 2002), 10/666,642 (filed September 18, 2003), and Provisional Application Nos. 60/411,837 (filed September 18, 2002), 60/125,814 (filed March 23, 1999), 60/166,228 (filed November 17, 1999), 60/310,847 (filed August 9, 2001), 60/336,049 (filed November 19, 2001), and 60/434,166 (filed December 17, 2002) be added to the list of domestic priority data as claimed by applicant for the above-referenced patent application.

I, the undersigned, hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the instant application or any patent issued thereon.

Respectfully submitted,  
MENDEL BIOTECHNOLOGY, INC.

Date: December 16, 2004



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**PETITION TO EXPEDITE DECISION ON PETITION**  
**UNDER 37 CFR §1.182**

Dear Sir:

In reference to the above-identified patent application, Applicants respectfully request the Office of Petitions expedite the Decision on Petition for the Petition to Accept an Unintentionally Delayed Domestic Priority Claim Under 37 CFR §1.78(a)(3) that is filed herewith.

All priority claims were contained in the first paragraph of the specification and listed in the Oath & Declaration at the time the above-referenced application was originally filed. More specifically, Applicants claimed 19 priority documents, eight provisional and 11 non-provisional applications using the language "claim the benefit

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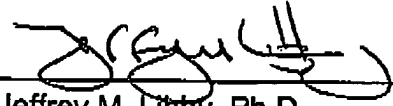
of" which may have been unclear regarding the relationship to the priority applications. As a result, the a majority of the priority documents were not listed on the Filing Receipt.

Accordingly, Applicants file herewith a Petition to Accept an Unintentionally Delayed Domestic Priority Claim, together with the requisite surcharge and petition fee, and a copy of the Second Supplemental Preliminary Amendment that is filed concurrently with the Petition which amends the specification to clarify the relationships between the provisional and non-provisional priority applications and the above-referenced application.

In addition to the fees provided for above, Applicants have authorized an additional petition fee of \$130.00 as set forth in CRR §1.17(h) for the Petition to Expedite the Decision on Petition. If for any reason the Commissioner finds that the fees set forth in the Fee Transmittal inadequate to cover this filing, the Commissioner is authorized to charge Mendel Biotechnology, Inc. Deposit Account No. 50-1025 the correct fee to said Deposit Account, as the Commissioner deems appropriate.

Respectfully submitted,  
MENDEL BIOTECHNOLOGY, INC.

Date: December 16, 2004

  
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